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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,171	11/09/1999	ANDREAS BLECKMANN	BEIERSDORF59	6227
7590	01/27/2004		EXAMINER	
Norris McLaughlin & Marcus PA 220 East 42nd Street 30th Floor New York, NY 10017			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/436,171	BLECKMANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Gina C. Yu	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 October 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-5,7-9 and 11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-5,7-9 and 11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on October 10, 2003. Claim rejections made under 35 U.S.C. § 112, first paragraph as indicated in the previous Office action dated July 10, 2003 are withdrawn in view of claim amendments. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the same Office action are maintained for the reasons of record.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3, 5, 7-9 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (WO 98/17232) in view of Dupuis et al. (US 6338858).

Rejection is maintained for the reasons of record.

2. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber and Dupuis as applied to claims 1, 3, 5, 7-9 and 11, and further in view of Yoneyama (US 5015469).

Rejection is maintained for the reasons of record.

### ***Response to Arguments***

Applicant's arguments filed October 10, 2003 have been fully considered but they are not persuasive.

Applicants pose the issue of whether as of the filing date of the present application (Nov. 9, 1999) what would have motivated a skilled artisan to modify the

Art Unit: 1617

teachings of Schreiber to arrive at the presently claimed invention when there is no teaching of how to modify the prior art. Examiner respectfully disagrees with the applicants. The present invention is not a process of making a composition but a composition itself. How the Schreiber composition is modified is made is not considered in determining the patentability of the instant claims. Rather, the issue here is whether Schreiber in view of the secondary references, which were published and/or filed before the present application, would have motivate the routineer to come up with the presently claimed invention at all.

Applicants' argue that no motivation to make the present invention exist because the cited references provide "almost infinite number of possible permutations of their invention". However, applicants offer no explanation as to why the skilled artisan would not have been motivated to modify the prior arts to make the present invention as examiner had proposed in the rejection. Examiner had indicated in the previous Office action that the motivation to add the old and well-known cationic polymers of Dupuis to the Schreiber composition would have been obvious because both prior art compositions are W/O stick emulsions such as lipsticks, and that it is known to use the cationic polymers for conditioning effect. The motivation to employ liquid paraffin to modify the composition of the combined references is found in Yoneyama. Examiner had indicated that the combined references use isopropyl myristate and silicone oils and Yoneyama teaches that liquid paraffin is substituted for isopropyl myristate or silicone oils. Applicants' argument that there are too many ingredients in the prior arts to find a motivation to employ the recited components of the claimed invention is unpersuasive

because, as the rejections indicate, the objective teachings of the prior arts are clear and specific, and the routineer would have found motivations to use the old and well-known conventional cosmetic ingredients to make the presently claimed emulsion.

Examiners respectfully disagrees with applicants' distinction of the present case from the precedents. While applicants argue that In re McLaughlin is distinct from the present case allegedly because it would have been impossible to come up with applicants' invention without applicants' disclosure at the time of the invention. The argument is not well taken because both Schreiber and Yoneyama were published well before the filing date of the present invention, while Dupuis's earliest filing date also precedes the present application. The cited references are valid prior arts which provide objective teachings that the applicants' components are old and well-known, and motivate a skilled artisan to use them to modify the Schreiber composition as discussed in the rejection. Similarly, while applicants cite the case laws such In re Fine and Texas Instruments Inc. v. International Trade Commission, there are no facts in the present case to support applicants' position that the rejections are based on hindsight. Examiner maintains the position that the motivation to modify the Schreiber composition by adding a conditioning cationic polymer and substitute the oil with another conventional cosmetic oil is clearly found in the cited references. The mere fact that there are numerous ingredients and components in the prior art inventions does not rebut the specific teachings of the references. The rejections are deemed proper.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

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